

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO. 09/855,502
ATTORNEY DOCKET NO. Q64471

REMARKS

Claims 1-11 and 13-16 have been examined on their merits.

The Examiner objects to claims 13 and 16 as being dependent upon a cancelled claim. Applicants herein amend claim 13 to correct a dependency error. The amendment to claim 13 does not raise any new issues requiring further search and/or consideration by the Examiner, and reduces potential issues for appeal. Entry and consideration of the amendment to claim 13 is respectfully requested.

Claims 1-11 and 13-16 are all the claims presently pending in the application.

1. Claims 1-11, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berry *et al.* (U.S. Patent No. 6,256,030) in view of Brozowski *et al.* (U.S. Patent No. 6,559,871). Applicants respectfully traverse the rejection of claims 1-11, 14 and 15 at least for the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

1. The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
2. The proposed modification of the prior art must have had a reasonable expectation of

success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).

3. The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner acknowledges that Berry *et al.* do not disclose the association between key lists and each object. *See* August 8, 2003 Final Office Action, pg. 3. The Examiner argues,

however, that Brozowski *et al.* supply the necessary disclosure to overcome the acknowledged deficiencies of Berry *et al.*

The combination of Berry *et al.* and Brozowski *et al.* fails to teach or suggest the inheritance of key lists between child graphical elements and their respective parent graphical elements, as recited in claim 1. The combination of Berry *et al.* and Brozowski *et al.* has no teaching whatsoever with respect to key lists being associated with graphical elements, and inheriting key lists between parent and child graphical elements, as recited in claim 1. Although the Examiner argues that Brozowski *et al.* discloses parent and child objects in Figure 2, there is no teaching or suggestion in the combination of Berry *et al.* and Brozowski *et al.* of the inheritance of key lists between child graphical elements and their respective parent graphical elements. Brozowski *et al.* further disclose tree navigator user interfaces for the manipulation of data, but Brozowski *et al.* do not disclose that the tree representations support and/or perform inheritance between parent and child graphical elements. For example, the Examiner relies upon Figure 2 as teaching that objects 161 and 162 are children of object 151, but critically, the Examiner has not identified any teaching in Brozowski *et al.* regarding the inheritance of key lists associated with graphical elements between parent and child objects. Thus, Applicants believe that the Examiner has not met the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants further believe that one of ordinary skill in the art would not have been motivated to combine Berry *et al.* with Brozowski *et al.* The Examiner asserts that one would have been motivated by the alleged tree presentation disclosed by Brozowski *et al.* However, claim 1 recites that child graphical elements inherit the key lists associated with their parent graphical elements. In

the Final Office Action, the Examiner does not even states that Brozowski *et al.* disclose inheritance of key lists between parent and child graphical elements. Since Brozowski *et al.* lacks any teaching with respect to inheritance of key lists between child and parent graphical elements, Applicants submit that one of ordinary skill would not have been motivated to combine Berry *et al.* with Brozowski *et al.* Therefore, Applicants believe that the Examiner has not met the motivation prong of a *prima facie* case of obviousness as well.

Thus, Applicants believe that claim 1 is allowable over the combination of Berry *et al.* and Brozowski *et al.* at least for the reasons set forth above, and further believe that claims 2-5 and 14 are allowable as well, at least by virtue of their dependency from claim 1.

Claim 6 has similar recitations as claim 1. Applicants believe that claim 6 is allowable over the combination of Berry *et al.* and Brozowski *et al.* for the same reasons as claim 1, namely the lack of disclosure with respect to key list inheritance between child graphical elements and parent graphical elements. For the sake of brevity, Applicants incorporate by reference the claim 1 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 6 as well. Applicants further believe that claims 7-10 and 15 are allowable as well, at least by virtue of their dependency from claim 6.

Claim 11 has similar recitations as claim 1. Applicants believe that claim 1 is allowable over the combination of Berry *et al.* and Brozowski *et al.* for the same reasons as claim 1, namely the lack of disclosure with respect to key list inheritance between child graphical elements and parent graphical elements. For the sake of brevity, Applicants incorporate by reference the claim 1 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of

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obviousness as applying to claim 11 as well. Applicants further believe that claims 13 and 16 are allowable as well, at least by virtue of their dependency from claim 11.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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Date: October 17, 2003